

INTERFERENCE DIGEST

Interference No. 105,256

Paper No.

Name: Marcus F. Boehm et al.

Serial No.: 08/141/496

Patent No.

Title: Compounds having selective activity for retinoid X receptors, and means for modulation of processes mediated by retinoid X receptors

Filed: 10/22/93

Interference with Dawson et al.

DECISION ON MOTIONS

Administrative Patent Judge, _____ Dated, _____

FINAL DECISION

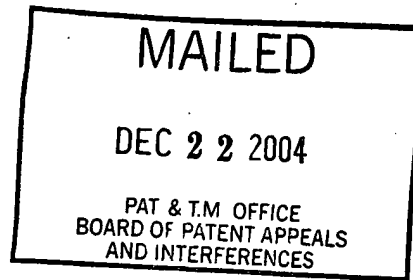
Board of Patent Appeals and Interferences, _____ Dated, _____

Court, _____ Dated, _____

REMARKS

This should be placed in each application or patent involved in interference in addition to the interference letters.

Filed by:
James T. Moore
Administrative Patent Judge
Mail Stop Interference
P.O. Box 1450
Alexandria VA 22313-1450
Tel: 571-272-9797
Fax: 571-273-0042



Paper 1

Filed
December 22, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge James T. Moore)

MARCIA I. DAWSON, JAMES F. CAMERON,
PETER D. HOBBS, LING JONG,
MAGNUS PFAHL, XIAO-KUN ZHANG,
and
JURGEN M. LEHMANN
Junior Party
(Patent 5,837,725 and Patent 5,466,861),

v.

MARCUS F. BOEHM, RICHARD A. HEYMAN,
LIN ZHI
and
STACIE C. KOCH
Senior Party
(Application 08/141,496).

Patent Interference No. 105,256

DECLARATION

Part A. Declaration of interference

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the application, patents, counts, and claims

designated as corresponding or as not corresponding to the counts appear in Parts E and F of this DECLARATION.

Part B. Judge managing the interference

Administrative Patent Judge James T. Moore has been designated to manage the interference. 37 CFR § 41.104(a) [Bd. R. 104(a)].

Part C. Standing order

A Trial Section STANDING ORDER [SO] accompanies this DECLARATION. The STANDING ORDER applies to this interference.

Part D. Initial conference call

A telephone conference call to discuss the interference is set for **1:00 p.m. on February 18, 2005** (the Board will initiate the call).

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile (SO ¶ 4.5) a list of the motions (Bd. R. 120; Bd. R. 204; SO ¶ 26) the party intends to file.

A sample schedule for taking action during the motion phase appears as Form 2 in the STANDING ORDER. Counsel are encouraged to discuss the schedule prior to the conference call and to agree on dates for taking action. A typical motion period lasts approximately eight (8) months. Counsel should be prepared to justify any request for a longer period.

Part E. Identification and order of the parties

Junior Party

Named inventors: MARCIA I. DAWSON, MENLO PARK CALIFORNIA
JAMES F. CAMERON, PALO ALTO CALIFORNIA
PETER D. HOBBS, MOSS BEACH CALIFORNIA
LING JONG, SUNNYVALE CALIFORNIA
MAGNUS PFAHL, SOLANA BEACH CALIFORNIA
XIAO-KUN ZHANG, LA JOLLA CALIFORNIA
JURGEN M. LEHMANN, SOLANA BEACH CALIFORNIA

Patents: 5,466,861, issued November 14, 1995 from
application 07/982,305, filed November 25, 1992;
5,837,725, issued November 17, 1998 from
application 08/448,991, filed May 24, 1995

Title: BRIDGED BICYCLIC AROMATIC COMPOUNDS AND THEIR USE IN
MODULATING GENE EXPRESSION OF RETINOID RECEPTORS (Same for
Both)

Assignee: 5,466,861 - SRI INTERNATIONAL, 333 RAVENSWOOD
AVENUE MENLO PARK, CA 94025-3493
5,837,725 - SRI INTERNATIONAL, 333 RAVENSWOOD
AVENUE MENLO PARK, CA 94025-3493

Accorded Benefit: 07/982,305, filed November 25, 1992

Senior Party

Named Inventors: MARCUS F. BOEHM, SAN DIEGO CALIFORNIA
RICHARD A. HEYMAN, ENCINITAS CALIFORNIA
LIN ZHI, SAN DIEGO CALIFORNIA
STACIE C. KOCH, SAN DIEGO CALIFORNIA

Application/Patent: 08/141,496, filed October 22, 1993

Title: COMPOUNDS HAVING SELECTIVE ACTIVITY FOR RETINOID X
RECEPTORS, AND MEANS FOR MODULATION OF PROCESSES MEDIATED
BY RETINOID X RECEPTORS

Assignee: LIGAND PHARMACEUTICALS INCORPORATED, 9393 TOWNE
CENTRE DRIVE, SUITE 100 SAN DIEGO, CA 92121

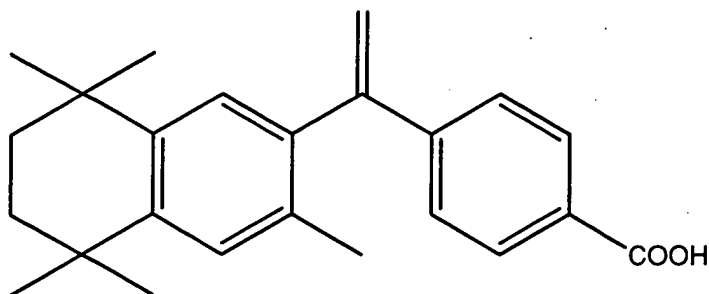
Accorded Benefit: 08/052,051, filed April 21, 1993
08/027,747, filed March 5, 1993
08/003,223, filed January 11, 1993
07/944,783, filed September 11, 1992
07/872,707, filed April 22, 1992

The senior party is assigned exhibit numbers 1001-1999. The junior party is assigned exhibit numbers 2001-2999. Bd. R. 154(c)(1). The senior party is responsible for initiating settlement discussions. SO ¶ 18.

Part F. Count and claims of the parties

Count 1

A compound of the formula



The claims of the parties are:

Dawson '861: Claims 1-23

Dawson '725: Claims 1-32

Boehm: Claim 70-81

The claims of the parties which correspond to Count 1 are:

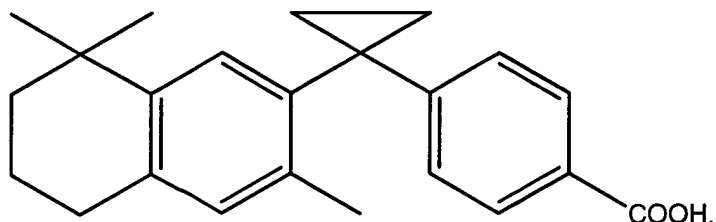
Dawson '861: Claim 1, 3, 4, and 12

Dawson '725: none

Boehm: Claim 70.

Count 2

A compound of the formula



The claims of the parties are:

Dawson '861: Claims 1-23

Dawson '725: Claims 1-32

Boehm: Claim 70-81

The claims of the parties which correspond to Count 2 are:

Dawson '861: Claims 1, 3, 4, and 8

Dawson '725: Claims 1, 3, and 16

Boehm: Claims 75 and 76.

The claims of the parties which do not correspond to Count 1 or 2, and therefore are not involved in the interference, are:

Dawson '861: Claims 2, 5-11, and 13-23.

Dawson '725: Claims 2, 4-15, and 17-32.

Boehm: Claims 71-74, and 77-81

Part G. Heading to be used on papers

The heading in SO Form 1 must be used on all papers filed in this interference. See SO ¶ 7.2.1. The administrative patent judge and parties must be indicated as follows:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge James T. Moore)

MARCIA I. DAWSON, JAMES F. CAMERON,
PETER D. HOBBS, LING JONG,
MAGNUS PFAHL, XIAO-KUN ZHANG,
and
JURGEN M. LEHMANN
Junior Party
(Patent 5,837,725 and Patent 5,466,861),

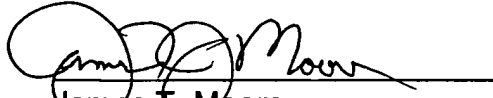
v.

MARCUS F. BOEHM, RICHARD A. HEYMAN,
LIN ZHI
and
STACIE C. KOCH
Senior Party
(Application 08/141,496).

Patent Interference No. 105,256

Part H. Order form for requesting file copies

When requesting copies of files, use of SO Form 4 will greatly expedite processing of the request. Please attach a copy of Part E of this DECLARATION with a hand-drawn circle around the patents and applications for which a copy of a file wrapper is requested.



James T. Moore
Administrative Patent Judge

Enc:

Copy of STANDING ORDER
Copy U.S. Patent 5,466,861 and 5,837,725
Copy of claims of 08/141,496

Revised September 2004

cc (via overnight delivery):

Attorney for Dawson

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UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES
BOX INTERFERENCE, WASHINGTON, D.C. 20231

Filed by: Judge James T. Moore
Telephone: 571-272-9797
Facsimile: 571-273-0042

MAILED

DEC 22 2004

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Applicants: BOEHM
Application No.: 08/141,496
Filed: 10/22/93
For: Compounds having selective activity for
retinoid X receptors, and means for modulation of
processes mediated by retinoid X receptors

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,256.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

A handwritten signature in black ink, appearing to be "J. T. Moore", written over a horizontal line.

JAMES T. MOORE
Administrative Patent Judge